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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte BENNETT M. RICHARD and STEVE ROSENBLATT

Appeal 2007-4530
Application 10/648,955
Technology Center 3600

Decided: March 31, 2008

Before TERRY J. OWENS, MURRIEL E. CRAWFORD, and
JOHN C. KERINS, *Administrative Patent Judges*.

KERINS, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Bennett M. Richard and Steve Rosenblatt (Appellants) seek our review under 35 U.S.C. § 134 of the final rejection of Claims 1-15 and 18-20. Prior to this appeal, Claims 16 and 17 were allowed. We have jurisdiction under 35 U.S.C. § 6(b) (2002). We AFFIRM.

THE INVENTION

Appellants' claimed invention is to a method for positioning a tubular in a borehole, including the steps of delivering the tubular into the borehole, positioning the tubular in the borehole after the tubular is delivered into the borehole, so that an annular space is left around the tubular, and expanding the tubular.

Claims 1 and 2, reproduced below, are representative of the subject matter on appeal.

1. A method of positioning a tubular in a borehole, comprising:

delivering the tubular into the borehole;

positioning the tubular in the borehole, after said delivering, in a manner that leaves an annular space around it; and

expanding the tubular.

2. The method of claim 1, comprising:

providing a plurality of openings in said tubular;

disposing an extendable member in each said opening.

THE REJECTION

The Examiner relies upon the following as evidence of unpatentability:

Wilson	US 5,228,518	July 20, 1993
Campbell	US 6,112,818	September 5, 2000
Chatterji	US 6,543,545 B1	April 8, 2003

Maguire

US 2003/0047322 A1

March 13, 2003

The following rejections are before us for review:

1. Claims 1 and 14 stand rejected under 35 U.S.C. § 102(b) as being anticipated by the Campbell patent.
2. Claims 1 and 15 stand rejected under 35 U.S.C. § 102(b) as being anticipated by the Chatterji patent.
3. Claims 2-5, 7-13, and 18-20 stand rejected under 35 U.S.C. § 103(a) as being obvious over the Chatterji patent in view of the Wilson patent.
4. Claims 1, 2, 4, 6, and 9 stand rejected under 35 U.S.C. § 103(a) as being obvious over the Maguire published patent application.

ISSUES

A first issue raised in this appeal is whether Appellants have shown that the Examiner erred in finding that Claims 1 and 14 are anticipated by the Campbell patent. An additional issue raised in this appeal is whether Appellants have shown that the Examiner erred in finding that Claims 1 and 15 are anticipated by the Chatterji patent. Another issue is whether Appellants have shown that the Examiner erred in concluding that Claims 2-5, 7-13 and 18-20 are obvious, and therefore unpatentable, under 35 U.S.C. § 103(a) in view of Chatterji and Wilson. One further issue is whether Appellants have shown that the Examiner erred in concluding that Claims 1, 2, 4, 6, and 9 are obvious in view of the Maguire reference.

FINDINGS OF FACT

The following enumerated findings are supported by at least a preponderance of the evidence. *Ethicon, Inc. v. Quigg*, 849 F.2d 1422, 1427 (Fed. Cir. 1988) (explaining the general evidentiary standard for proceedings before the Office).

1. The Campbell patent discloses a method of positioning a tubular in a borehole in which centralizers 17 are provided on the tubular to center the tubular in the borehole to maintain an annular spacing between the tubular and the borehole. (Campbell, Fig. 1; Col. 2, ll. 38-40).

2. The Campbell method further involves expanding the tubular, which includes a step of jarring down on the string and pushing the expander tool 10 into the tubular. (Campbell, Figs. 1, 3; Col. 3, ll. 12-16).

3. The centralizers 17 in Campbell are collapsed upon expansion of the tubular. (Campbell, Col. 2, ll. 40-41).

4. The Chatterji patent discloses a method of positioning a tubular in a borehole, in which centralizers 48 are employed to position the tubing string in a spaced relation with the well bore wall. (Chatterji, Fig. 1; Col. 4, ll. 19-21).

5. The Wilson patent discloses a method for positioning a tubular 60 in a borehole, in which a plurality of extendable members 50 are provided in an associated plurality of openings in the wall of the tubular. (Wilson, Figs. 2, 3; Col. 3, ll. 48-65).

6. The Wilson patent states that centralizers or bow springs had previously been employed to space a tubular from the walls of a wellbore during the cementing process. Wilson notes that the use of bow springs creates substantial frictional forces during delivery of the tubular, and that

the bow springs are generally somewhat fragile and prone to failure.
(Wilson, Col. 1, ll. 33-45).

7. The Wilson patent proposes the use of extendable members 50 positioned in openings in the wall of tubular 60 as a replacement for bow springs and other centralizers, in order to overcome or avoid limitations and disadvantages with those components. (Wilson, Col. 1, l. 67-Col. 2, l. 3).

8. The Maguire patent discloses a method involving delivering an inner tubular into a wellbore in which an outer tubular or casing has been placed. Maguire teaches that the inner tubular 200 is to be disposed coaxially with the outer tubular prior to expanding the inner tubular. (Maguire, Fig. 4; p. 3, ¶[0033]).

9. Maguire discloses that, prior to expanding the inner tubular, the carbide inserts 220 projecting outwardly from the outer wall of the inner tubular are not to bite into the outer tubular or casing 400, such that a grip would be formed between the inner tubular and the outer tubular. (Maguire, Fig. 4; p. 3, ¶[0035]).

10. In the Maguire method, the inner tubular is positioned, prior to the expansion thereof, such that, upon being expanded, the outer surface of the inner tubular is expanded into contact with the inner wall of the outer tubular. (Maguire, Fig. 5; p. 3, ¶[0036]).

PRINCIPLES OF LAW

Claims on appeal are not to be confined to specific embodiments described in the specification. *Phillips v. AWH Corp.*, 415 F.3d 1303, 1323 (Fed. Cir. 2005) (*en banc*). During *ex parte* prosecution, claims must be interpreted as broadly as their terms reasonably allow, since Applicants have

the power during the administrative process to amend the claims to avoid the prior art. *In re Zletz*, 893 F.2d 319, 321-22 (Fed. Cir. 1989). The broadest reasonable meaning of claim terms will be in accord with their ordinary usage as they would be understood by one of ordinary skill in the art, taking into account whatever enlightenment by way of definitions or otherwise that may be afforded by the written description. *In re Morris*, 127 F.3d 1048, 1054 (Fed. Cir. 1997).

Anticipation of a claim exists when each and every element set forth in the claim is found, either expressly or inherently described, in a single prior art reference. *Verdegaal Bros. v. Union Oil Co.*, 814 F.2d 628, 631 (Fed. Cir.), *cert. denied*, 484 U.S. 827 (1987); *In re Cruciferous Sprout Litig.*, 301 F.3d 1343, 1349 (Fed. Cir. 2002). Once a prima facie case of anticipation has been established, the burden shifts to the Appellant to prove that the prior art product does not necessarily or inherently possess the characteristics of the claimed product. *In re Best*, 562 F.2d 1252, 1255 (CCPA 1977); *In re Spada*, 911 F.2d 705, 708-09 (Fed. Cir. 1990).

In *Graham v. John Deere Co.*, 383 U.S. 1, 17-18, (1966), the Supreme Court set out a framework for applying the statutory language of § 103:

[T]he scope and content of the prior art are to be determined; differences between the prior art and the claims at issue are to be ascertained; and the level of ordinary skill in the pertinent art resolved. Against this background the obviousness or nonobviousness of the subject matter is determined. Such secondary considerations as commercial success, long felt but unsolved needs, failure of others, etc., might be utilized to give light to the circumstances surrounding the origin of the subject matter sought to be patented.”

There is a need for caution in granting a patent based upon a combination of elements found in the prior art. In particular, a patent for a

combination which only unites old elements with no change in the respective functions of the elements withdraws what is already known into the field of monopoly and diminishes the resources available to skillful practitioners.

KSR Int'l v. Teleflex Inc., 127 S.Ct. 1727, 1739 (2007).

A person of ordinary skill is also a person of ordinary creativity, not an automaton. *KSR Int'l*, 127 S.Ct. at 1742.

ANALYSIS

Anticipation rejection of Claims 1 and 14

Appellants do not argue separately for the patentability of Claim 14, therefore, that claim will stand or fall with Claim 1. *See*, 37 C.F.R. § 41.37(c)(1)(vii) (2007).

Appellants take issue with the Examiner's finding that Claim 1 is anticipated by the Campbell patent, contending that the Campbell patent does not disclose a method in which a tubular is positioned after the delivering of the tubular into a borehole. In support of that contention, Appellants note that the Campbell system employs bow spring centralizers 17 that, "keep the tubular centralized at all times during delivery and do no positioning at all without any movement of the tubular into the well." (Appeal Br. 4). Appellants contend that their claims are limited to a method in which the positioning is performed *solely* after the tubular is delivered into the borehole, and thus the Campbell patent does not identically disclose the claimed method.

The Examiner replies on two fronts, namely that, (1) Claim 1 is not restricted to a method in which the tubular is positioned only after the tubular has been delivered into the borehole (Answer 4, 5), and (2) the

centralizers of Campbell will continue to position the tubular after the tubular has been delivered (Answer 4). We are not persuaded that the Examiner's position is erroneous.

The first of the Examiner's contentions is not unlike having to "prove a negative." Claim 1 indeed includes a step of positioning the tubular in the borehole in a manner that leaves an annular space around it, and that the positioning is to be done after the tubular is delivered into the borehole. Claim 1, however, by its terms, does not preclude the performance of a positioning step *during* said delivering, as well.

Appellants seemingly do not understand how such a conclusion can be logically reached¹, yet the only support for their position comes not from the claim language itself, but rather in a plea that we apply an, "estoppel by amendment *and argument* that positioning occurs when delivery is over." (Reply Br. 2)(emphasis added). That mantra is repeated at the next page of the Reply Brief, where Appellants urge that, "the amendment to claim 1 *and the argument presented with* [the] *amendment* ... clearly and unambiguously state that what is claimed is only positioning after conclusion of delivery." (Reply Br. 3)(emphasis added).

The amendment to the claim that Appellants refer to is the addition of the phrase, "after said delivering," in characterizing the positioning step. (Reply Br. 2). Were this amendment language to have affirmatively precluded the possibility that positioning of the tubular could also occur or be performed *during* delivery, Appellants arguments would likely be

¹ Appellants argue in their Reply Brief that, when the terms "delivery" and "after" are put together, "the only meaning that is logical and clear is that there is no positioning going on until after delivery is over." (Reply Br. 3).

considered in a different light. However, the phrase in question does not preclude this possibility, nor does any other language of Claim 1. As such, the arguments made by Appellants in this respect amount to nothing more than an attempt to have us read a further limitation into the claim that corresponds to a disclosed preferred embodiment. We decline to do so, and, indeed, lack the authority to do so. *Phillips*, 415 F.3d at 1323.

We further agree with the Examiner that the bow springs 17 disclosed in Campbell operate to position the tubular in the borehole to leave an annular space around the tubular, even after it has been delivered into the borehole. Appellant acknowledges that, after the Campbell tubular has been delivered, “[T]he tubular ... holds the position it has because of the centralizer [bow springs 17].” (Reply Br. 3)(Finding of Fact 1). This is simply saying, in a different way, that the bow springs 17 position the tubular (hold the position of the tubular) after it has been delivered.

To illustrate, once the tubular is delivered into the borehole, further actions are performed, for example, there is a jarring down on the string to shear screws 26 and a pushing of the expansion tool into the tubular, in commencing the expansion of the tubular. (Finding of Fact 2). Such jarring and pushing action would tend to cause sections of the tubular to attempt to deflect laterally. The bow springs would act to resist such movement, and if lateral movement were to occur, the bow springs would act to position or centralize the tubular, in that the bow springs of Campbell are subsequently collapsed as the tubular is expanded. (Finding of Fact 1, 3).

We have carefully considered the remaining arguments presented by Appellants, relative to how they interpret Claim 1. The arguments evidence, by and large, that Appellants are attempting to read limitations into the claim

that are not actually there. We will affirm the rejection of Claims 1 and 14 as anticipated by the Campbell patent.

Anticipation rejection of Claims 1 and 15

Appellant does not argue separately for the patentability of Claim 15, therefore, that claim will stand or fall with Claim 1. 37 C.F.R. § 41.37(c)(1)(vii) (2007).

The Chatterji patent is asserted by the Examiner to anticipate Claims 1 and 15. (Answer 3, 5). The construction of the tubing string in Chatterji relies on centralizers 48 to position the tubing string in a spaced relation with the well bore wall (Finding of Fact 4), much in the same manner as in the Campbell patent addressed above.

The issue joined by the Examiner and Appellants relative to this rejection is identical to that discussed above with respect to the Campbell patent. The Examiner asserts that the Chatterji device, which positions a tubular during delivery via the use of centralizers, also positions the tubing string after delivery. Appellants counter that the claims require positioning after delivery, to the exclusion of any positioning being performed during delivery. Appellants assert that this excludes the possibility of using the centralizers to effect the positioning.

For the reasons stated above with respect to the rejection of Claims 1 and 14 as anticipated by Campbell, we are not persuaded that the Examiner's finding that the Chatterji patent anticipates Claims 1 and 15 is in error. We will thus affirm the rejection of Claims 1 and 15.

Obviousness rejection of Claims 2-5, 7-13, and 18-20

Appellants do not argue separately for the patentability of any of these claims, apart from one another. The claims will therefore stand or fall together. We will select Claim 2 as representative of the group for the purposes of deciding the appeal as to these claims. 37 C.F.R. § 41.37(c)(1)(vii) (2007).

Claim 2 depends from Claim 1, with the method further including providing a plurality of openings in the tubular, and disposing an extendable member in each opening. The Examiner, citing to the Chatterji patent, acknowledges that the method performed in that patent does not include these two steps. (Answer 5, 6). The Examiner further cites to the Wilson patent as teaching the provision of these elements in connection with a method of positioning a tubular in a borehole (Answer 6)(Finding of Fact 5), and contends that it would have been obvious to a person of ordinary skill in the art to modify the method disclosed by Chatterji in view of the teachings of Wilson, such that the method would be performed using extendable members deployed through openings in the tubular, in order to position the tubular. The Examiner notes that the motivation for this modification is found in the Wilson patent, which describes that centralizers like that disclosed in Chatterji can possibly be damaged during run in, and that the extendable members deployed through openings in the tubular minimize the risk of incurring such damage. (Answer 6)(Finding of Fact 6).

Appellants contend that the Examiner has failed to show sufficient motivation for combining the teachings of these references (Appeal Br. 5), and that the references teach away from the combination in several respects (Reply Br. 4). Common to all of Appellants' arguments in support of these

contentions is that Chatterji teaches positioning during run-in and subsequently expanding the tubular, whereas Wilson teaches centralizing after delivery, but performs no subsequent tubular expansion.

Appellants urge that, “[T]he Wilson reference has no bearing to expansion. For that reason the structures it teaches for positioning are not useful to one skilled in the art who contemplates expansion after delivery and positioning.” (Reply Br. 4-5). In a related vein, Appellants contend that, contrary to the position taken by the Examiner, actively operated pistons that are internal during delivery and later get actuated, and passive bow spring centralizers, are not readily interchangeable concepts. (Appeal Br. 5). Were these statements supported in any way by facts or other evidence, or even logical analysis, they could possibly be probative of the patentability of the claims in this group. However, the statements are simply conclusory and thus are not persuasive. Particularly as to the latter assertion directed to the interchangeability of the actuated pistons and the bow spring centralizers, the Wilson patent evidences that the extendable pistons are proposed specifically to replace passive bow spring centralizers. (Finding of Fact 7).

Even though the Supreme Court in *KSR* has instructed that the “teaching, suggestion, motivation” (TSM) test is not to be rigidly applied, and is not the only approach that can be taken in determining the patentability or lack thereof under 35 U.S.C. § 103(a), the Court advised that the test can provide helpful insight. *KSR Int’l.*, 127 S.Ct. at 1741. The Court further noted that, “it can be important to identify a reason that would have prompted a person of ordinary skill in the relevant field to combine the elements in the way the claimed new invention does.” *Id.* We find that the

Examiner has adequately and persuasively presented evidence, in the Wilson patent, that persons skilled in the art had motivation and a logical reason for combining the teachings of Chatterji and Wilson. In the absence of evidence or logical reasoning indicating to the contrary, we find no error in the Examiner's conclusion that method set forth in these claims would have been obvious to a person of ordinary skill in the art.

We will affirm the rejection of Claims 2-5, 7-13, and 18-20, under 35 U.S.C. § 103(a).

Obviousness rejection of Claims 1, 2, 4, 6, and 9

Appellants do not argue for the separate patentability of any of these claims, apart from one another. We will select Claim 1 as representative of the group for the purposes of deciding the appeal as to these claims. 37 C.F.R. § 41.37(c)(1)(vii) (2007).

Appellants argue that Claim 1 is not obvious in view of Maguire, in that the Maguire design has no need for creating an annular space for any purpose after delivery (Appeal Br. 6), and thus “uses a method that has no need for positioning after delivery.” *Id.* Appellants attempt to substantiate this conclusion by noting that, since the design and method in Maguire involve delivering an inner tubular into an outer tubular, and then expanding the inner tubular into engagement with the outer tubular, the “positioning is irrelevant because the operation of the roller expander will expand the inner tubular against the outer tubular regardless of the initial position of the inner tubular with respect to the outer tubular.” (Reply Br. 6).

Regardless as to whether there is or is not a *need* to create an annular space between the inner and outer tubulars in Maguire prior to expanding the

inner tubular, Maguire clearly evidences that such an annular space is desired. Maguire describes that the inner tubular 200 is to be disposed coaxially within the casing prior to expanding the inner tubular. (Finding of Fact 8). Maguire further states that, prior to the expanding of the tubular, the carbide inserts 220 which project outwardly from the outer wall of the inner tubular 200 are not to be biting the casing 400 so as to form a grip between the tubular and the casing. (Finding of Fact 9). Finally, Maguire notes that the inner tubular is expanded until its outer surface contacts the inner surface of the outer casing (Finding of Fact 10), which reinforces that Maguire intends to have the inner tubular positioned prior to expansion so that there is an annular space around it.

In view of these findings, we are not persuaded that the Examiner erred in concluding that it would have been obvious to a person of ordinary skill in the art to include in the method disclosed by Maguire the positioning of the tubular after its delivery into the wellbore. We will, accordingly, affirm this rejection.

CONCLUSIONS OF LAW

We conclude that Appellants have failed to establish that reversible error exists in the rejection of Claims 1 and 14 under 35 U.S.C. § 102(b) as anticipated by Campbell.

We conclude that Appellants have failed to establish that reversible error exists in the rejection of Claims 1 and 15 under 35 U.S.C. § 102(b) as anticipated by Chatterji.

We further conclude that Appellants have failed to establish that reversible error exists in the rejection of Claims 2-5, 7-13, and 18-20 under 35 U.S.C. § 103(a), as unpatentable over Chatterji in view of Wilson.

We further conclude that Appellants have failed to establish that reversible error exists in the rejection of Claims 1, 2, 4, 6, and 9 under 35 U.S.C. § 103(a), as unpatentable over Maguire.

ORDER

The decision of the Examiner to reject Claim 1, 14, and 15 under 35 U.S.C. § 102(b) is AFFIRMED.

The decision of the Examiner to reject Claims 2-13 and 18-20 under 35 U.S.C. § 103(a) is AFFIRMED.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a) (2007).

AFFIRMED

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